

Attachment 1

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## occlude

1. To shut up; to close.

2. <chemistry> To take in and retain; to absorb; said especially with respect to gases; as iron, platinum, and palladium occlude large volumes of hydrogen.

Origin: L. Occludere, occlusum; ob (see Ob-) + claudere to shut.

Source: Websters Dictionary

(01 Mar 1998)

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**Previous:** occipitothalamic, occipitothalamic radiation, occipitotransverse position, occiput

**Next:** occluded virus, occludens junction, occluder

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Come to the European Association for Cancer Education Annual Meeting

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tion filing in order to eliminate text that is not essential to obtaining a Japanese patent. Claims that will not provide value to the applicant can be cancelled at any time during the life of the Japanese patent to reduce Examination, Issue and/or Annuity fees. In addition, the applicant should give its Japanese patent attorney an opportunity to review and revise the specification before PCT or Paris Convention filings, at least for particularly important inventions, as such review and revision may both reduce the total cost of obtaining the Japanese patent and increase the breadth and strengthen the validity of the claims that ultimately are allowed.

## Did You Ever Notice? Official Notice in Rejections\*

Lance Leonard Barry\*\*

**J**erry Seinfeld, a popular stand-up comedian and television actor, is known for beginning his comedy routines with the question, "Did you ever notice...?"<sup>1</sup> Many Patent Examiners (Examiners) at the United States Patent and Trademark Office (PTO) could answer the question positively. This is because many of them "notice," i.e., take official notice of, well-known facts when composing rejections of claims.

Under the doctrine of official notice, an Examiner need not produce a printed document to prove the existence of a fact that was well known at the time of an invention.<sup>2</sup> He may instead take official notice as to its existence.<sup>3</sup> Taking official notice bypasses the normal process of proof. It relies on facts and opinions not supported by evidence on

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1 See David Katzman, *Did You Ever Notice how People Will Read Anything*, 81 Daily Egyptian Online 107 (Mar. 5, 1996) (<http://www.dailyegyptian.com/eg/030596/people/read.html>).

2 PTO, *MANUAL OF PATENT EXAMINING PROCEDURE* (M.P.E.P.) § 2144.03 (7th ed., July 1998). The M.P.E.P. has been held to describe "procedures on which the public can rely." *Pallix Corp. v. Mosshoeff*, 758 F.2d 594, 606, 223 USPQ 243, 252, modified, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Kaghan*, 387 F.2d 398, 401, 56 USPQ 130, 132 (CCPA 1967); *Ethicon v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988); *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 662, 231 USPQ 649, 651 (Fed. Cir. 1986).

3 See *Ex parte Christy*, 201 USPQ 689, 695 (Bd. Pat. App. & Int. 1976) ("[I]f facts... must support the legal conclusion of obviousness under 35 USC 103. Such facts must flow from the prior art either by way of specific references or by generally known facts of which official notice may be taken." (emphasis added)).

the record.<sup>4</sup> As such, it is imperative that Examiners and patent attorneys and agents understand the guidance given on the use of official notice to reject claims.

This note aims to increase their understanding in three parts. Part I explains the rationale for official notice. Part II addresses its scope. Part III outlines the use of notice.

### I. RATIONALE FOR OFFICIAL NOTICE

As mentioned above, an Examiner need not produce a reference<sup>5</sup> to prove the existence of a fact well known at the time of an invention.<sup>6</sup> He may take official notice of its existence.<sup>7</sup> Administrative efficiency and administrative expertise are two rationales for the doctrine of official notice. These will be explained *seriatim*.

Administrative efficiency is one rationale for official notice. Like its courtroom counterpart judicial notice,<sup>8</sup> official notice derives from the legal maxim *manifesta [or notoria] non indigent probatione*, i.e., "what is known need not be proved." The maxim may be traced so far back in civil and canon law that it is probably coeval with legal procedure itself.<sup>9</sup> Back in 1875, for example, the United States Supreme Court observed that to require proof of every fact "would be utterly and absolutely absurd."<sup>10</sup> Where a fact is known, the process of proving it is "time-consuming and unduly formal."<sup>11</sup> When a fact has been proven already, further proof becomes "tiresome, redundant, and lacking in common sense."<sup>12</sup> At times, moreover, even an obvious fact can be difficult or time-consuming to prove, without affecting a result that was never in doubt.<sup>13</sup>

<sup>4</sup> 2 KENNETH S. BROWN ET AL., MCCORMACK ON EVIDENCE § 359, at 536 (John W. Strong ed., 4th ed. 1992).

<sup>5</sup> A reference is a patent or other printed document used in the rejection of claim. M.P.E.P. § 904.

<sup>6</sup> *Id.* at § 2144.03.

<sup>7</sup> See Crissy, 201 USPQ at 695.

<sup>8</sup> That notion of common knowledge may be judicially noticed is a doctrine long and well established. *In re Malcomb*, 129 F.2d 529, 553, 54 USPQ 235, 238 (CCPA 1942).

<sup>9</sup> JAMES BRADLEY THAYER, A PLEADING TREATISE ON EVIDENCE AT COMMON LAW 277 (Boston, Little Brown & Co. 1898).

<sup>10</sup> *Brown v. Piper*, 91 U.S. 37, 42 (1875).

<sup>11</sup> BROWN, *supra* note 2, § 359, at 537-38.

<sup>12</sup> *Id.* at 538.

<sup>13</sup> *Id.*

An Examiner is allotted a limited time to dispose of a patent application<sup>14</sup> and is also directed to bring prosecution of the application to as speedy a conclusion as possible.<sup>15</sup> Official notice empowers the Examiner to use time efficiently to make a speedy and just determination of issues in the application.<sup>16</sup> More specifically, it frees the Examiner from having to spend unnecessary time finding a reference to prove the existence of a fact well known at the time of an invention.<sup>17</sup>

Administrative expertise is another rationale for official notice. Administrative agencies were created to allow regulation of matters by persons knowledgeable in the matters.<sup>18</sup> They were also created to serve as repositories of specialized knowledge and experience.<sup>19</sup> It would "defeat [this] existence" of these agencies to force adherence to traditional methods of proof when alternative and equally fair methods are available.<sup>20</sup>

As an administrative agency, the PTO possesses technical knowledge and expertise in determining the patentability of inventions.<sup>21</sup> It is a knowledge and expertise that Justice (then Circuit Judge) Stevens admitted generally is not possessed by federal judges.<sup>22</sup> In particular, the Examiners of the PTO are highly trained scientists and engineers<sup>23</sup> of the highest-caliber.<sup>24</sup> They possess an independent and specialized

<sup>14</sup> Cf. Michael J. Marham, *Strategic Concerns when Pursuing Foreign Patents in The Computer Arts*, THE COMPUTER LAWYER, Mar. 1998, at 17, 25 (noting that the European Patent Office's examiners are "allowed more time to examine each application" than the PTO's Examiners); DAVID PRESSMAN, PATENT IT YOURSELF 1346 (5th ed. 1996) (noting that Examiners are expected to dispose of a certain number of patent applications).

<sup>15</sup> M.P.E.P. § 706.07. See also PTO, A PATENT AND TRADEMARK OFFICE REVIEW 8-9 (Fiscal Year 1997) (setting a first strategic goal of reducing "patent cycle time").

<sup>16</sup> M.P.E.P. § 904.02.

<sup>17</sup> *Id.* at § 2144.03 ("[T]he examiner should not be obliged to spend time to produce documentary proof").

<sup>18</sup> 4 BASIL J. MEZNESS ET AL., ADMINISTRATIVE LAW § 25.01 (1980).

<sup>19</sup> BROWN, *supra* note 2, § 359, at 538.

<sup>20</sup> *Id.*

<sup>21</sup> *Plastic Container Corp. v. Continental Plastics of Oda, Inc.*, 708 F.2d 1554, 1557, 219 USPQ 26, 28 (10th Cir. 1983).

<sup>22</sup> *Chicago Rawhide Mfg. Co. v. Crans Packing Co.*, 523 F.2d 452, 458, 187 USPQ 540, 545 (7th Cir. 1975). See also *Nat'l Bus. Systems, Inc. v. AM Int'l, Inc.*, 743 F.2d 1227, 1232, 223 USPQ 1011, 1014 (7th Cir. 1984) ("The courts generally defer to the technical expertise possessed by the [PTO] in originally issuing a patent. This expertise and corresponding judicial deference are the practical underpinnings of the statutory presumption of validity surrounding patents."); *Aqua-Chem, Inc. v. Baldwin-Lima-Hamilton Corp.*, 67 USPQ 257, 261 (N.D. Ill. 1970) ("The [PTO] has developed a certain amount of technical expertise which most judges lack.")

<sup>23</sup> PTO, *Patent Examiner Positions*, ¶ 1 (last modified July 1, 1998) (<http://www.uspto.gov/web/offices/nc/olrpa/olr/employment/exam.htm#org>).

<sup>24</sup> See PTO, *supra* note 15, at 8.

technical expertise.<sup>25</sup> Such expertise is seldom possessed by a reviewing court.<sup>26</sup> Official notice permits the Examiners to use fully their expertise in adjudicating the patentability of discoveries of inventors throughout the world.<sup>27</sup>

## II. SCOPE OF OFFICIAL NOTICE

Official notice typically is employed to supplement or clarify a reference, i.e., to justify or explain an inference drawn from it. A fact so noticed serves to fill gaps that might exist in other evidence cited to support a rejection.<sup>28</sup> A noticed fact usually is not employed as the principal evidence for a rejection.<sup>29</sup>

Like judicial notice, official notice may be taken of a fact of "wide notoriety,"<sup>30</sup> e.g., a fact commonly known by laymen everywhere.<sup>31</sup> *In re Howard*<sup>32</sup> provides a prototypical example of a widely notorious fact. *Howard* involved the patentability of claims specifying a method of pricing merchandise. The method reduced the amount of manual handling of merchandise stocked and displayed in a retail grocery store.<sup>33</sup>

<sup>25</sup> *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970). See also *Semiconductor Energy Laboratory Co. v. Samsung Elec. Co.*, 46 USPQ2d 1874, 1877 n.6 (E.D. Va. 1998) ("[E]xaminers are skilled in the art insofar as they are technically competent to understand information and references in some technical or scientific field..."); *Creative Indus. Inc. v. Mobil Chem. Corp.*, 13 USPQ2d 1534, 1537 (N.D. Ill. 1989). "The patent examiner, of course, possessed the technical expertise necessary to understand the prior art as well as the subject matter of patent applications within his area of responsibility." *Rixson, Inc. v. Rasol-Milgo, Inc.*, 551 F.Supp. 163, 174, 217 USPQ 941, 950 (D. Del. 1982) ("The patent examiner had the... reference and technical expertise to evaluate it.").

<sup>26</sup> *In re Wieschert*, 370 F.2d 927, 952, 152 USPQ 247, 266 (CCPA 1967) (Smith, J., dissenting). 27 PTO, *supra* note 23, § 1.

<sup>28</sup> *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970). *Ahlert* uses the expression "judicial notice" rather than official notice. Technically speaking, judicial notice is for a court while official notice is for an administrative agency. Robert Muir, *The Utilization of Both Judicial Notice and Official Notice by Administrative Agencies*, 16 *Ad. L. Rev.* 333, 334 (1964). It is common—albeit obfuscating—to refer to the taking of official notice by an Examiner as judicial notice. See, e.g., PETER D. ROSENBERG, *PATENT LAW FUNDAMENTALS* § 15.06[2] (2d ed. 1995) ("Official notice taken of matters beyond the record is referred to as 'judicial notice';" *Irish H. Danner, Combating Obviousness Rejections Under 35 U.S.C. Section 103*, 6 *ALB. L.J. Sci. & Tech.* 159, 195 (1996) ("If an Examiner does not specifically cite prior art references but uses judicial notice").

<sup>29</sup> *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421. But see *In re Howard*, 394 F.2d 869, 157 USPQ 615 (CCPA 1968) (using judicial notice, in the words of a concurring opinion, "to find that a system exists which anticipates that of the application or is so nearly like it as to make the application an obvious variation").

<sup>30</sup> *In re Howard*, 394 F.2d 869, 870, 157 USPQ 615, 616 (CCPA 1968). 31 *Cf.* 29 *Am. Jur. 2d Evidence* § 33 (1994) ("A fact might qualify for judicial notice because it is common knowledge everywhere. The basic appearance of a snowman, for example, is common knowledge.")

<sup>32</sup> 394 F.2d 869, 157 USPQ 615.

<sup>33</sup> *Id.* at 869–70, 157 USPQ at 615–16.

In affirming a rejection of the claims, the United States Court of Customs and Patent Appeals (CCPA)<sup>34</sup> took notice of the retailing practice of listing goods for sale by code along with the price of each. This practice helped a sales clerk to learn the amount to charge a customer purchasing the goods.<sup>35</sup> The CCPA observed that the practice related back to the "proverbial country merchant" who has his present-day counterpart in the supermarket cashier who tapes a price list of advertised "specials" to his cash register.<sup>36</sup> The court also noted the deluge of mail order catalogs that list merchandise by code along with its price, which "common observation cannot escape," as further evidence of the wide notoriety of the retailing practice.<sup>37</sup>

*In re Fox*<sup>38</sup> offers another example of a widely notorious fact. *Fox* involved the patentability of claims specifying a method for distributing audio information. The method employed conventional equipment to make a master tape-recording of a lecture. The master recording was transmitted to a distribution point such as a school library. At the library copies of the master were made for persons wishing to listen to the lecture on their own equipment at their own convenience. When finished listening to a taped copy, a person could return the copy to have a new lecture reproduced thereon from another master tape-recording at the library. This new reproduction would, of course, entail erasing the recording already on the tape.<sup>39</sup>

In affirming a rejection of the claims, the PTO's Board of Appeals (Board)<sup>40</sup> took official notice and the CCPA took judicial notice of "the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it."<sup>41</sup> This fact is notorious. Consumers recording over a prerecorded video tape or audio tape-recording take it for granted that the original recording will be erased during the new recording.<sup>42</sup>

<sup>34</sup> The CCPA was the predecessor of the United States Court of Appeals for the Federal Circuit (Federal Circuit) in reviewing patentability appeals from the PTO. *Lance Leonard Barry, Precedent for Ex Parte Patent Prosecution*, 78 *J. PAT. & TRADEMARK OFF. SOC'Y* (B41, 844–45 (1996).

<sup>35</sup> *Howard*, 394 F.2d at 870, 157 USPQ at 616.

<sup>36</sup> *Id.* at 870–71, 157 USPQ at 616.

<sup>37</sup> *Id.*, 157 USPQ at 616.

<sup>38</sup> 471 F.2d 1405, 176 USPQ 340 (CCPA 1973).

<sup>39</sup> *Id.* at 1405, 176 USPQ at 340.

<sup>40</sup> The Board of Appeals was the forerunner of the Board of Patent Appeals and Interferences in reviewing patentability appeals from the decision of a Primary Examiner within the PTO. *Barry, supra* note 34, at 853.

<sup>41</sup> 471 F.2d at 1407, 176 USPQ at 341.

<sup>42</sup> Like the CCPA, the Federal Circuit also has taken notice of widely notorious facts in its review of decisions on patentability. *In re Raynes*, 7 F.3d 1037, 28 USPQ2d 1630 (Fed. Cir. 1993),

Unlike judicial notice,<sup>43</sup> official notice may be taken not only of a fact that is widely notorious but also of a fact that is capable of "instant and unquestionable demonstration."<sup>44</sup> *In re Ahlert*<sup>45</sup> provides an archetypical example of an instant and unquestionably demonstrable fact. *Ahlert* involved the patentability of claims specifying a technique for controlling the rate of cooling a weld between two sections of railroad rail. The technique produced a tough, crack-free weld having reduced internal stresses.<sup>46</sup>

In affirming an Examiner's rejection of the claims, the Board took notice that it was common practice in the art of welding to postheat a weld after completing the corresponding welding operation. It also officially noticed the practice in the art of adjusting the intensity of a flame according to heat requirements.<sup>47</sup> On appeal, the applicant contested the propriety of the Board's notice, urging that the facts were "'not so notorious and well known that any court would be justified in taking judicial notice thereof.'"<sup>48</sup> The CCPA was not persuaded. It upheld the right to take official notice of facts that "while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute."<sup>49</sup>

*In re Perkins*<sup>50</sup> offers another example of an instant and unquestionably demonstrable fact.<sup>51</sup> *Perkins* involved the patentability of claims specifying an alloy containing tantalum and titanium. Addition

provides an example of a widely notorious fact noticed by the court. In affirming a rejection of claims specifying an interactive automobile service station, the Federal Circuit took judicial notice of the "ubiquitous" use of video to display programming information and other information. *Id.* at 1040, 28 USPQ2d at 1632. The fact is notorious. Laymen frequently consult video screens for the arrival and departure times of trains or airplanes, for weather reports, or for stock quotes. See also *In re Wright*, 866 F.2d 422, 426, 9 USPQ2d 1649, 1652 (Fed. Cir. 1989) (taking notice of the "widespread" use of "carbonless paper" in manifold business forms).

<sup>43</sup> Official notice is broader than judicial notice. Any matter capable of being judicially noticed also is capable of being officially noticed. The converse is not true. Officially noticed matters do not necessarily fall into categories that bring them within the confines of judicial notice. *MEZDRES*, *supra* note 18, § 25.01, at n.4.

<sup>44</sup> *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (confusingly using the expression "judicial notice" rather than "official notice").

<sup>45</sup> 424 F.2d 1088, 165 USPQ 418 (CCPA 1970).

<sup>46</sup> *Id.* at 1089, 165 USPQ at 418-19.

<sup>47</sup> *Id.* at 1090, 165 USPQ at 420.

<sup>48</sup> *Id.* at 1091, 165 USPQ at 420.

<sup>49</sup> *Id.*, 165 USPQ at 420.

<sup>50</sup> 346 F.2d 981, 146 USPQ 63 (CCPA 1965).

<sup>51</sup> There is room for reasonable minds to disagree over whether a particular fact is widely notorious or instantly and unquestionably demonstrable.

of titanium to tantalum produced improvements over the properties of unalloyed tantalum.<sup>52</sup>

In affirming a rejection of the claims, the Board took notice that for many years tantalum had been worked into sheet and wire form and used for its corrosion resistance in the chemical industry.<sup>53</sup> The CCPA accepted this notice and affirmed the Board's decision.<sup>54</sup> Admittedly, this fact is not widely notorious. Many laymen do not know what tantalum is...not to mention its uses and properties. The fact, however, is instantly and unquestionably demonstrable by one of ordinary skill in the art.

The scope of official notice is not as broad as it might appear at first. The CCPA warned that it would construe narrowly the scope of facts that may be noticed and the conclusions that may be drawn from the facts.<sup>55</sup> *In re Spormann*<sup>56</sup> provides an example of this narrow construction. *Spormann* concerned the patentability of claims specifying a process for producing solid alkali metal sulfites from alkali metal hydroxides or carbonates. The process involved "spraying the latter, in an aqueous solution, into a dry gas containing sulfur dioxide, the temperature and humidity of the gas being such as to immediately vaporize the water to the end that very little sulfate is produced."<sup>57</sup>

In affirming a rejection of the claims, the Board appeared to take notice that spray drying was an old expedient for obtaining a solute in dry form.<sup>58</sup> The CCPA reversed the rejection. "While we have heard of spray drying," the court commented, "it is not a technique of which we would feel free to take judicial notice."<sup>59</sup> The CCPA added "if the Patent Office<sup>60</sup> wishes to rely on what 'Those familiar with spray drying would know,' it must produce some reference showing what such knowledge consists of."<sup>61</sup>

Accordingly, an Examiner should exercise care in deciding whether a fact is amenable to official notice. He should not take notice

<sup>52</sup> *Perkins*, 346 F.2d at 982, 146 USPQ at 64.

<sup>53</sup> *Id.* at 984, 146 USPQ at 66.

<sup>54</sup> *Id.*, 146 USPQ at 66.

<sup>55</sup> *In re Pardo*, 684 F.2d 912, 917, 214 USPQ 673, 677 (CCPA 1982); *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). But cf. *In re Howard*, 394 F.2d 869, 872, 157 USPQ 615 (CCPA 1968) (Kirkpatrick, J., concurring) (observing that "the limits of judicial notice, particularly in patent cases, are expanding and the field of notice is now pretty broad").

<sup>56</sup> 363 F.2d 444, 447, 150 USPQ 449, 452 (CCPA 1966).

<sup>57</sup> *Id.* at 444, 150 USPQ at 449 (emphasis omitted).

<sup>58</sup> *Id.* at 447, 150 USPQ at 452.

<sup>59</sup> *Id.*, 150 USPQ at 452.

<sup>60</sup> Before 1975, the PTO was known as the Patent Office. *Barry, supra* note 34, at 845 n.35.

<sup>61</sup> 363 F.2d at 447, 150 USPQ at 452.

of a fact normally subject to the possibility of rational disagreement among reasonable men.<sup>62</sup> Facts constituting the state of the art, for example, are in this category.<sup>63</sup> If the Examiner has a "reasonable doubt" whether a fact may be noticed, he should not take notice of it.<sup>64</sup>

### III. USE OF OFFICIAL NOTICE

The CCPA has required that an applicant for a patent be "apprised" of a taking of official notice.<sup>65</sup> Accordingly, an Examiner should make clear when and for what he is relying on notice. The former can be accomplished by including the expression "official notice is taken" in an Office action.<sup>66</sup> The latter can be accomplished by mapping the exact and complete language of a pending claim to a noticed fact.<sup>67</sup>

An Examiner bears the initial burden of presenting a *prima facie* conclusion of obviousness.<sup>68</sup> Although official notice relieves the Examiner from producing a reference to prove the existence of a well known fact,<sup>69</sup> it does not free him from the other requirements for establishing a *prima facie* conclusion.<sup>70</sup> Among these requirements are

<sup>62</sup> *In re Eynard*, 480 F.2d 1364, 1370; 178 USPQ 470, 474 (CCPA 1973); *In re Barr*, 444 F.2d 588, 591 n.5, 170 USPQ 330, 334 n.5 (CCPA 1971).

<sup>63</sup> *Eynard*, 480 F.2d at 1370, 178 USPQ at 474. Also in this category is "the skill of a person or ordinary skill in either computer programming or design in 1970," which was held to be not a proper subject for notice in 1982. *In re Pardo*, 684 F.2d 912, 917, 214 USPQ 673, 677 (CCPA 1982).

<sup>64</sup> *Cf. Brown v. Piper*, 91 U.S. 37, 42-43 (1875) (regarding judicial notice).

<sup>65</sup> *In re Albert*, 424 F.2d 1088, 1091, 165 USPQ 418, 421 (CCPA 1970).

<sup>66</sup> See PTO, TECHNOLOGY CTR. 2700, WORKGROUP 2760 TRAINING MANUAL 4-8 to 4-9, 4-11 (Sept. 25, 1998). An Office action is an official, written communication from the PTO to an applicant or his attorney that raises some objection, requirement, or rejection and includes a concise explanation of the reasons therefor. The Office action may also indicate any allowable subject matter. PETER D. ROSENBERG, PATENT LAW FUNDAMENTALS § 15.03(1) (2d ed. 1998 rev.).

<sup>67</sup> *Cf. LANCE LEONARD BARRY ET AL., OBVIOUSNESS UNDER 35 U.S.C. 103, BASIC STUDENT'S MANUAL 27* (Aug. 4, 1998) (instructing an Examiner to use "the complete and exact language of the claims" when writing a rejection).

<sup>68</sup> *In re Piasochi*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). If the Examiner does not make a *prima facie* case, an applicant is under no obligation to submit evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Once the Examiner does produce a *prima facie* case, the burden of going forward with evidence shifts to the applicant. *Piasochi*, 745 F.2d at 1471-72, 223 USPQ at 788.

<sup>69</sup> M.P.E.P. § 2144.03.

<sup>70</sup> *Ex parte Grochowski*, No. 95-1343, at 5 (Bd. Pat. App. & Int. June 27, 1995) (observing "that just because elements are old and well known in the art does not render their combination obvious per se").

employing analogous art and identifying a suggestion for combining teachings. These requirements will be explained *separatim*.

To qualify as prior art for obviousness, art must be analogous, i.e., in the field of an applicant's endeavor or reasonably pertinent to the particular problem with which the applicant was concerned.<sup>71</sup> When writing a rejection employing official notice an Examiner should state that a fact being noticed was well known *in an analogous art* and should name the art.<sup>72</sup> The Examiner should also state that the fact was well known at the time of the invention, i.e., at the time the patent application was filed.<sup>73</sup>

Once it has been shown that a noticed fact could have been used because it was known in an analogous art, a suggestion, i.e., a motivation, must be shown for its proposed use. The suggestion must be based on more than the mere existence of the noticed fact.<sup>74</sup> The prior art as a whole must have contained something to suggest the "desirability" of using the noticed fact to modify a prior art reference.<sup>75</sup> An Examiner accordingly must explain a suggestion for employing the noticed fact in a rejection.<sup>76</sup>

When the decision of an administrative agency such as the PTO rests on official notice of a fact, a party is entitled to challenge the notice.<sup>77</sup> If an applicant for a patent does not "seasonably" traverse a fact officially noticed during examination, it becomes an admission of prior art.<sup>78</sup> A seasonable challenge is "a demand for evidence made as

<sup>71</sup> *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

<sup>72</sup> See, e.g., *Lucerne Prods., Inc. v. Culex-Hammer, Inc.*, 568 F.2d 784, 798, 195 USPQ 472, 481 (6th Cir. 1977) (taking notice of the fact that the principles of canning, pivoting and bridging were well known "in the mechanical arts").

<sup>73</sup> The applicant of *In re Lewis*, 96 F.2d 1009, 37 USPQ 786 (CCPA 1938), argued that the Board's expression that a broadcasting practice was "now well known in the art" should be construed to mean that the practice was known at the time the Board wrote its opinion. The CCPA declined to do so. The court instead interpreted the expression as meaning that the practice was known at the time the applicant's application was filed. *Id.* at 1011, 37 USPQ at 788. It is better to preclude such an argument by stating that a fact was well known at the time of the invention.

<sup>74</sup> *Grochowski*, No. 95-1343, at 5.

<sup>75</sup> *Lindenmum Maschinenfabrik GmbH v. American Host and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

<sup>76</sup> *Cf. Barry*, *supra* note 67, at 27 (instructing an Examiner to explain a suggestion/motivation for modifying references used in a rejection).

<sup>77</sup> See Administrative Procedure Act, 5 U.S.C. § 556(e) (1996).

<sup>78</sup> M.P.E.P. § 2144.03. *Cf. In re Gumbert*, 125 F.2d 1020, 1023, 52 USPQ 465, 468 (CCPA 1942) (accepting a statement by an Examiner of what was well known in the art because an applicant failed to challenge the statement "before the Patent Office."); *In re Chlovenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (refusing to consider an appellant's statement in his brief because *inter alia* the appellant failed to demand that an Examiner produce authority for his statement); *In re Lundberg*, 244 F.2d 543, 551, 113 USPQ 530, 537 (CCPA 1957) ("[T]he board



soon as practicable during prosecution."<sup>79</sup> An applicant is charged with rebutting a taking of notice in the response to the Office action in which the notice was taken.<sup>80</sup>

A challenge may take the form of a demand for evidence that a noticed fact was well known.<sup>81</sup> If an applicant demands such evidence, an Examiner should cite a reference showing the fact in the next Office action.<sup>82</sup> Such a citation is unnecessary if the applicant does not challenge the notice.<sup>83</sup> If the reference is cited *only* as evidence of the prior official notice, its addition does not amount to a new ground of rejection.<sup>84</sup> Barring any other impediments to finality,<sup>85</sup> the Office action may be made final.<sup>86</sup>

### CONCLUSION

This note sought to increase understanding of official notice in three parts. The first part explained that the rationale for official notice was twofold. Notice helps an Examiner use his limited time efficiently and permits him to rely on his scientific or engineering expertise. The second part addressed the scope of official notice. It explained that the Examiner may take notice of a fact that is widely notorious or is instantly and unquestionably demonstrable.

It stated that the use of feedback members in electrical circuits (was) well known. Appellants have failed to question the accuracy of the statement... and did not present any evidence to contradict it. Therefore we are constrained to accept it as true."<sup>79</sup>

<sup>79</sup> M.P.E.P. § 2144.03.

<sup>80</sup> *Id.*

<sup>81</sup> *Id.* The CCPA has stated that a challenge to notice taken by the Board must contain adequate information or argument to create *on its face* a reasonable doubt about the propriety of the notice. *In re Boon*, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA 1971). At least one patent practitioner, moreover, has advised that an applicant challenging notice taken by an Examiner should include affidavit evidence by a person skilled in the specific art relating to the patent application. DOWNER, *supra* note 28, at 195.

<sup>82</sup> M.P.E.P. § 2144.03.

<sup>83</sup> *In re Sun*, 31 USPQ2d 1451, 1454 (Fed. Cir. 1993).

<sup>84</sup> See *Boon*, 439 F.2d at 727-28, 169 USPQ at 234.

<sup>85</sup> A second or subsequent Office action on the merits shall be final unless an Examiner has introduced a new ground of rejection that is neither necessitated by an applicant's amendment of claims nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 C.F.R. § 1.97(c). Where information is submitted in an IDS during the period, the Examiner may use the information submitted and still make the next Office action final regardless of whether the claims have been amended, provided that he introduces no other new ground of rejection that was not necessitated by amendment to the claims. A second or subsequent action on the merits in any application will not be made final, furthermore, if it includes a rejection on newly cited art, other than information submitted in an IDS filed under § 1.97(c), of any claim not amended by the applicant regardless of the fact that other claims may have been amended to require newly cited art. M.P.E.P. § 706.07(a).

<sup>86</sup> *Id.* at § 2144.03; see also PTO, *supra* note 66, at 4-8.

The third part outlined the use of official notice. It explained that the Examiner should make clear when and for what he is relying on notice. He should also ensure that a noticed fact was well known in an analogous art and that a suggestion existed for using it. The third part also explained that in response to an applicant's seasonable challenge of the taking of notice, the Examiner should cite a reference showing the noticed fact in the next Office action. Barring any other impediments to finality, the Examiner should still make the action final. Armed with the knowledge provided in this note Examiners should have a greater understanding of when and how to use official notice... and a new insight into the comedy of Jerry Seinfeld!

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